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OFFICE OF PETITIONS

In re Patent No. 7,110,125	:	
Ono, et al.	:	DECISION REGARDING
Issue Date: September 19, 2006	:	PATENT TERM ADJUSTMENT
Application No. 09/585,607	:	AND
Filed: June 2, 2000	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No.	:	CERTIFICATE OF CORRECTION
03560.002607	:	

This letter is in response to the "LETTER OF GOOD FAITH AND CANDOR REGARDING PATENT TERM ADJUSTMENT", filed November 15, 2006, requesting correction of the patent term adjustment.

The petition is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **zero (0)** days.

On September 19, 2006, the above-identified application matured into U.S. Patent No. 7,110,125. On November 15, 2006, patentees timely filed the instant application for patent term adjustment.

The patent issued with a Patent Term Adjustment of one hundred twenty-one (121) days. Patentees state that they were erroneously assessed applicant delay of thirty-nine (39) days for filing a "REQUEST FOR CONSIDERATION OF TIMELY FILED INFORMATION" on May 23, 2006. In addition, patentees point the Office's attention to the fact that the PTO delay of 80 days for failure to issue the application within three years may be longer than appropriate.

In reviewing the application, it is determined that applicants were not assessed the correct number of days of delay due to the abandonment of the application. The Office mailed a Restriction Requirement on September 19, 2001, setting a thirty (30) day period for reply. As no reply was timely filed, the application became abandoned on October 20, 2001. Applicants filed a petition to revive on August 5, 2002, which was granted in a decision mailed on September 4, 2002. Under 37 C.F.R.

§ 1.704(c)(3), applicants should have been assessed delay beginning on the date the application was abandoned, and ending on the date the decision granting the petition to revive was mailed. As such, applicants should have been assessed three hundred nineteen (319) days of delay (from October 20, 2001 to September 4, 2002), not two hundred twenty-nine (229) days.

In addition, a review of the application reveals that applicants should have been assessed additional delay pursuant to 37 C.F.R. § 1.704(c)(8) for filing an IDS on August 16, 2005. Applicants filed an RCE on February 18, 2005. Subsequently, applicants filed an IDS on August 16, 2005. The IDS was not expressly requested by the examiner and did not include a § 1.704(d) statement. Accordingly, applicants should have been assessed one hundred forty-eight (148) days of delay under § 1.704(c)(8).

With regard to patentees' contention that they should not have been assessed delay of thirty-nine (39) days for the submission of a "REQUEST FOR CONSIDERATION OF TIMELY FILED INFORMATION" on May 23, 2006, patentees are correct. Because the paper was a request for an initialed copy of form PTO-1449 for an IDS that was previously filed (the IDS filed on August 16, 2005), it is determined that the assessed delay of thirty-nine (39) days in this situation is not warranted.

Lastly, patentees point the Office's attention to the fact that the PTO delay of eighty (80) days for failure to issue the application within three years may be longer than appropriate. Patentees are incorrect. The period of 80 days entered pursuant to 37 C.F.R. §1.702(b) is correct.

The application was filed on June 2, 2000. Accordingly, the Office had until June 2, 2003 to issue the application without accruing patent term adjustment for Office delay pursuant to 37 C.F.R. § 1.702(b). The application did not issue until September 19, 2006. However, the filing of a Request for Continued Examination (RCE) cuts off the ability to accumulate patent term adjustment under the three year provision. The time consumed by the filing of a request for continued examination is excluded from the calculation under 37 C.F.R. § 1.702(b). In this

instance, an RCE was first filed on October 8, 2003. Thus, the over three year period (June 3, 2003 to October 8, 2003) is 128 days.

Moreover, any days of Office delay for the over three year period pursuant to 37 CFR 1.702(b) which overlap with the days of Office delay accrued during the pendency of the application during the relevant period will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B) 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). Where a RCE has been filed, the relevant period for considering this overlap ends with the filing of the RCE. In this instance, prior to the filing of the first RCE, a total of 48 days was entered for Office delay.

Accordingly, at issuance, considering that the three year period ends with the filing of an RCE and the overlapping period, the Office entered an additional 80 days (128 for over three year - 48 overlapping days) for Office failure to issue the application within three years.

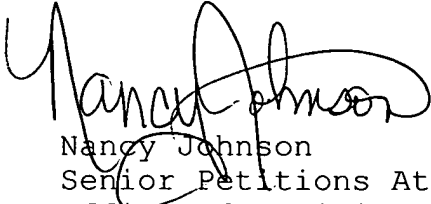
All of the other adjustments have been reviewed and found to be correct.

In view thereof, issuance of a certificate of correction pursuant to 35 U.S.C. 254 and 37 CFR § 1.322 is appropriate. The correct number of days of patent term adjustment is zero (0) days (481 (48+33+320+80)) days of PTO delay, reduced by 559 (8+35+5+44+148+319) days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks Patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **zero (0)** days subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to
Cliff Congo, Petitions Attorney, at (571)272-3207.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" written in a larger, more prominent script than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,110,125 B1

DATED : September 19, 2006

DRAFT

INVENTOR(S) : Ono et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 121 days

Delete the phrase "by 121 days" and insert – by 0 days--